



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/599,962

09/30/2008

Bernard Prandi

1759.241

7408

23405

7590

03/02/2011

HESLIN ROTHENBERG FARLEY & MESITI PC
5 COLUMBIA CIRCLE
ALBANY, NY 12203

EXAMINER

DANG, PHONG SON H

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

03/02/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,962	Applicant(s) PRANDI, BERNARD	
	Examiner SON DANG	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/16/2006, 10/16/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “elastic return means” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3773

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 7 recites “an elastic return means” which has not recites in the specification or in the drawing for one of ordinary skill in the art to understand, make and use of the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by US PG PUB No. 2002/0072752 A1 to Zucherman et al. (Zucherman).

In regards to claims 1-5 and 7-10:

Zucherman teaches:

A clamp comprising two arms (105, 107, Fig. 3c) with opposed gripping jaws (102, 104, Fig. 1) for supporting and positioning a superelastic osteosynthesis clip (the clip has not been positively recited, so this clip-related phrase is considered to be functional limitation), said osteosynthesis clip

Art Unit: 3773

comprising a web from which two flanges intended to be inserted into two portions of bone emerge, said clamp further comprising: a first means (212, Fig. 3c) for preventing jaws (102, 104, Fig. 1) of each arm (105, 107, Fig. 3c) from being opened in order to prevent clip from opening beyond a point at which the angle between flanges and web is greater than 90°; a second means (112, Fig. 3c) for preventing jaws (105, 107, Fig. 3c) from being closed in order to prevent clip from closing beyond a point at which the angle between flanges and the web is substantially 90°. The first means (212, Fig. 3c) comprises a component separately mounted on one of the arms (105, 107, Fig. 3c). The first means (212, Fig. 3c) consists of a protuberance on one of arms (105, 107, Fig. 3c). First means (212, Fig. 3c) comes into contact with an opposite arm (105, 107, Fig. 3c) of said two arms (105, 107, Fig. 3c) in order to prevent said opening of the jaws (102, 104, Fig. 1). The second means (112, Fig. 3c) comprises a component (112, Fig. 3c) separately mounted on one of the arms (105, 107, Fig. 3c) and comprising at least one tooth (serrations on 112, Fig. 3c) that cooperates with a sharp edge (serrations within bore 141, Fig. 3c) on an opposite arm of the two arms (105, 107, Fig. 3c). The two arms (105, 107, Fig. 1) comprises an elastic return means (114, Fig. 1) to keep the arms (105, 107, Fig. 1) apart. The first means (212, Fig. 3c) is adjustable so as to allow variation in an extent of cover-opening of the clip (functional limitation). The second means (112, Fig. 3c) is adjustable so as to allow parallel positioning of the flanges of the clip depending on the size of the web (functional limitation). For a superelastic

Art Unit: 3773

osteosynthesis clip which has a deformation curve as a function of stress having a line B-C that represents opening of said clip and a line C-B'-A' that represents clip closing, over-opening of said clip by first means (11) corresponds substantially to portion C-C' of the curve where C' corresponds to intersection of the tangent lines between a return plateau, closure B'-A' and a fall from C (the clip has not been positively recite therefore this is considered to be functional limitation).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman in view of US Patent No. 6,635,072 B1 to Ramamurti et al. (Ramamurti).

In regards to claim 6:

Zucherman teaches:

A clamp as claimed in claim 5 (see rejection of claim 5 above).

Zucherman fails to teach:

Component can swivel relative to arm on which it is mounted.

Ramanurti teaches:

Component (10, Fig. 1) can swivel relative to arm (20, 22, Fig. 1) on which it is mounted.

Art Unit: 3773

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the ratchet of Zucherman with the ratchet of Ramanurti for controlling the opening and closing for the jaw as an equivalent substitution of one known mechanism for another as it is well known in the art that such a mechanism would yield expectable results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON DANG whose telephone number is (571)270-5809 or email address at son.dang@uspto.gov. The examiner can normally be reached on Monday-Friday 7:30 AM - 5:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/599,962
Art Unit: 3773

Page 7

/S. D./
Examiner, Art Unit 3773

/Julian W. Woo/
Primary Examiner, Art Unit 3773